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			EXAMINER WASSUM, LUKE S	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/665,237

Applicant(s)

POLTORAK, ALEXANDER I.

Examiner

Luke S. Wassum

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2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20030918.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

The Invention

1. The claimed invention is a method and apparatus for identifying/analyzing potential patent infringement.

Priority

2. The Applicant's claim to domestic priority under 35 U.S.C. § 119(e) based upon U.S. Provisional Patent Application 60/419,184, filed on 17 October 2002, is acknowledged.

Information Disclosure Statement

3. The Applicants' Information Disclosure Statement, filed 18 September 2003, has been received and entered into the record. Since the Information Disclosure Statement complies with the provisions of MPEP § 609, the references cited therein have been considered by the examiner. See attached form PTO-1449.

Specification

4. The disclosure is objected to because of the following informalities:

In the first paragraph of page 1 of the Applicant's specification, the priority claim is cited as being based upon U.S. Provisional Patent Application 60/380,235. This application number should be cited as 60/419,184.

Appropriate correction is required.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 1-100 of this application conflict with claims 1-100 of Application No. 10/367,228. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

7. Claims 1-100 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-100 of copending Application No. 10/367,228. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Objections

8. Claims 3, 13, 15, 29, 39, 65 and 89 are objected to because of the following informalities:

These claims contain the limitation wherein software programs, modules and/or algorithms are stored within a database. This is contrary to the conventional understanding of a database in the art. The Applicant is requested to clarify the claimed arrangement of software being stored within a database (as well as how and why this is accomplished), or alternately to amend the claims.

9. Claim 13 is objected to because of the following informalities:

This claim contains a typographical error "...at least of a..." should be "...at least *one* of a...".

10. Regarding claims 15, 39, 65 and 89, these claims contain the limitation "a search engines", which should be "a search engine".

Appropriate correction is required.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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12. Claims 27-50 and 77-100 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

13. Regarding claims 27 and 77, these claims recite a method and apparatus for identifying and/or analyzing potential patent infringement, but fails to recite a tangible result, a requirement for compliance with the provisions of 35 U.S.C. § 101 for a process that can be interpreted as being implemented through software.

For a result to be tangible, it must be more than just a thought or a computation; it must have real-world value rather than an abstract result. For instance, an additional step that included either storing the generated claim chart information in a database, or displaying the generated claim chart information to a user would constitute a tangible result. Claims 27 and 77, however, merely cite 'transmitting the information...to a user device' as the result.

This interpretation of 35 U.S.C. § 101 is consistent with the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, published on 26 October 2005, which can be found at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf, particularly with respect to ANNEX IV Computer-Related Nonstatutory Subject Matter, beginning on page 50.

14. Claims 28-50 and 78-100, fully incorporating the deficiencies of their respective parent claims, are likewise rejected.

Claim Rejections - 35 USC § 112

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 77-100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claim 77 recites the limitation "the processing device" in the 'processing' limitation. There is insufficient antecedent basis for this limitation in the claim.

18. Claims 78-100, fully incorporating the deficiency of their parent claim, are likewise rejected.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 1-12, 14, 15, 19-36, 38, 39, 43-62, 64, 65, 69-86, 88, 89 and 93-100 are rejected under 35 U.S.C. 102(b) as being anticipated by **Snyder et al.** (U.S. Patent 6,038,561).

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21. Regarding claim 1, **Snyder et al.** teaches an apparatus for identifying and/or analyzing potential patent infringement as claimed, comprising:

- a) an input device for inputting information regarding a patent (see disclosure that the user enters a patent number, col. 26, lines 42-44; see also Query Entry Screen in drawing Figure 10A; see also col. 27, lines 22-24; see also Claim Query Entry Screen in drawing Figure 11A);
- b) a processing device for processing the information regarding the patent, wherein the processing device identifies at least one independent claim of the patent (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.), wherein the processing device formulates a search or a search query containing information corresponding to the at least one independent claim (see disclosure of the comparison of the specified patent and individual claims in the dataset, col. 26, lines 44-58; see also disclosure that the user may specify a comparison between a single claim and all other claims in the dataset, col. 27, lines 13-17 and 32-34), wherein the processing device searches information regarding at least one of a product, products, a service, and services, wherein the processing device obtains and processes information regarding at least one of a product, products, a service, and services, relevant to the at least one independent claim in conjunction with information contained in the at least one independent claim (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25; see also disclosure that the selected patent/claim is compared with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34), and

further wherein the processing device generates claim chart information containing information regarding the at least one of a product, products, a service, and services (see disclosure that the user can display matching claims side-by-side, col. 27, lines 1-5 and 32-36; see also drawing Figure 10C et seq.); and

- c) at least one of a display device for displaying information contained in the claim chart information and an output device for outputting information contained in the claim chart information (see drawing Figure 10C et seq.).

22. Regarding claim 27, **Snyder et al.** teaches an apparatus for identifying and/or analyzing potential patent infringement as claimed, comprising:

- a) a receiver for receiving information regarding a patent (see disclosure that the user enters a patent number, col. 26, lines 42-44; see also Query Entry Screen in drawing Figure 10A; see also col. 27, lines 22-24; see also Claim Query Entry Screen in drawing Figure 11A);
- b) a processing device for processing the information regarding the patent, wherein the processing device identifies at least one independent claim of the patent (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.), wherein the processing device formulates a search or a search query containing information corresponding to the at least one independent claim (see disclosure of the comparison of the specified patent and individual claims in the dataset, col. 26, lines 44-58; see also disclosure that the user may specify a comparison between a single

claim and all other claims in the dataset, col. 27, lines 13-17 and 32-34), wherein the processing device searches information regarding at least one of a product, products, a service, and services, wherein the processing device obtains and processes information regarding at least one of a product, products, a service, and services, relevant to the at least one independent claim in conjunction with information contained in the at least one independent claim (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25; see also disclosure that the selected patent/claim is compared with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34), and further wherein the processing device generates claim chart information containing information regarding the at least one of a product, products, a service, and services (see disclosure that the user can display matching claims side-by-side, col. 27, lines 1-5 and 32-36; see also drawing Figure 10C et seq.); and

- c) a transmitter for transmitting the information contained in the claim chart information to a user communication device (see drawing Figure 10C et seq.; see also disclosure that the client computer may be a portable computer, col. 10, lines 52-53).

23. Regarding claim 51, **Snyder et al.** teaches a computer-implemented method for identifying and/or analyzing potential patent infringement as claimed, comprising:

- a) inputting information regarding a patent into a processing device (see disclosure that the user enters a patent number, col. 26, lines 42-44; see also Query Entry Screen in

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drawing Figure 10A; see also col. 27, lines 22-24; see also Claim Query Entry Screen in drawing Figure 11A);

- b) processing the information regarding the patent with the processing device (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25);
- c) identifying at least one independent claim of the patent (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.);
- d) formulating a search or a search query containing information corresponding to the at least one independent claim (see disclosure of the comparison of the specified patent and individual claims in the dataset, col. 26, lines 44-58; see also disclosure that the user may specify a comparison between a single claim and all other claims in the dataset, col. 27, lines 13-17 and 32-34);
- e) searching information regarding at least one of a product, products, a service, and services (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25; see also disclosure that the selected patent/claim is compared with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34);
- f) obtaining and processing information regarding at least one of a product, products, a service, and services, relevant to the at least one independent claim in conjunction with information contained in the at least one independent claim (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25; see also disclosure that the

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selected patent/claim is compared with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34);

g) generating claim chart information containing information regarding the at least one of a product, products, a service, and services (see disclosure that the user can display matching claims side-by-side, col. 27, lines 1-5 and 32-36; see also drawing Figure 10C et seq.); and

h) at least one of displaying information contained in the claim chart information and outputting information contained in the claim chart information (see drawing Figure 10C et seq.).

24. Regarding claim 77, **Snyder et al.** teaches a computer-implemented method for identifying and/or analyzing potential patent infringement as claimed, comprising:

a) receiving information regarding a patent (see disclosure that the user enters a patent number, col. 26, lines 42-44; see also Query Entry Screen in drawing Figure 10A; see also col. 27, lines 22-24; see also Claim Query Entry Screen in drawing Figure 11A);

b) processing the information regarding the patent with the processing device (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25);

c) identifying at least one independent claim of the patent (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.);

- d) formulating a search or a search query containing information corresponding to the at least one independent claim (see disclosure of the comparison of the specified patent and individual claims in the dataset, col. 26, lines 44-58; see also disclosure that the user may specify a comparison between a single claim and all other claims in the dataset, col. 27, lines 13-17 and 32-34);
- e) searching information regarding at least one of a product, products, a service, and services (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25; see also disclosure that the selected patent/claim is compared with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34);
- f) obtaining and processing information regarding at least one of a product, products, a service, and services, relevant to the at least one independent claim in conjunction with information contained in the at least one independent claim (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25; see also disclosure that the selected patent/claim is compared with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34);
- g) generating claim chart information containing information regarding the at least one of a product, products, a service, and services (see disclosure that the user can display matching claims side-by-side, col. 27, lines 1-5 and 32-36; see also drawing Figure 10C et seq.); and

- h) transmitting the information contained in the claim chart information to a user communication device (see drawing Figure 10C et seq.; see also disclosure that the client computer may be a portable computer, col. 10, lines 52-53).

25. Regarding claims 2, 28, 52 and 78, **Snyder et al.** additionally teaches a computer-implemented method and apparatus including at least one of a computer, a personal computer, a desktop computer, a laptop or notebook computer, a central processing computer, and a server (see disclosure of the hardware configuration of the system, col. 9, line 20 through col. 10, line 53; see also drawing Figures 1A and 1B).

26. Regarding claims 3, 29, 53 and 79, **Snyder et al.** additionally teaches a computer-implemented method and apparatus including a database, wherein the database contains at least one of subject matter of at least one patent, at least one of a software program and algorithm for processing or parsing patent information, at least one of a software program and an algorithm for identifying at least one of a claim preamble, a claim element, and a claim limitation, at least one of a software program and an algorithm for formulating a search or a search query, product information for any number of products, product descriptions, descriptions of components, descriptions of product uses, services information, service descriptions, descriptions of processes, descriptions of service uses, a product catalog, a services catalog, an industry atlas, a trade journal, a technical journal, a book, a magazine, a publication, a Dialog database, a NERAK database, a Thomas Register database, a Derwent database, a patent database, at least one of a software program and an algorithm for generating a claim chart (see disclosure that both structured and non-structured

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documents can be searched, said structured documents including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45).

27. Regarding claims 4 and 54, **Snyder et al.** additionally teaches a computer-implemented method and apparatus including a transmitter for transmitting at least one of an information request to an information source computer and the claim chart information to a user communication device (see drawing Figure 10C; see also disclosure that the client computer may be a portable computer, col. 10, lines 52-53).

28. Regarding claims 5 and 55, **Snyder et al.** additionally teaches a computer-implemented method and apparatus including a receiver for receiving at least one of patent information from a user communication device and a response to a request for information from an information source computer (see disclosure that the user enters a patent number, col. 26, lines 42-44; see also Query Entry Screen in drawing Figure 10A; see also col. 27, lines 22-24; see also Claim Query Entry Screen in drawing Figure 11A; see also disclosure that the client computer may be a portable computer, col. 10, lines 52-53; see also col. 10, lines 20-33).

29. Regarding claims 6, 30, 56 and 80, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device at least one of processes and parses the text information of the patent in order to identify the claims of the patent (see disclosure that the patent documents are parsed to extract all of the individual patent claims, col. 26, lines 45-51; see also col. 11, lines 21-31; see also col. 12, lines 22-67 et seq.).

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30. Regarding claims 7, 31, 57 and 81, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device utilizes at least one of a word processing searching technique, a text analysis processing technique, and a semantic analysis processing technique, to identify the claims of the patent (see col. 12, lines 42-67 et seq.).

31. Regarding claims 8, 32, 58 and 82, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device at least one of processes and parses claim information of the patent in order to identify the at least one independent claim (see disclosure that the claims are analyzed in order to identify any dependencies to other claims, col. 12, lines 50-57).

32. Regarding claims 9, 33, 59 and 83, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device at least one of processes and parses the information contained in the at least one independent claim, wherein the processing device identifies text corresponding to the preamble and to at least one of a claim element and a claim limitation (see col. 6, lines 60-61; see also col. 11, lines 21-31; see also col. 12, lines 22-67).

33. Regarding claims 10, 34, 60 and 84, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device processes the text information corresponding to the claim preamble and to at least one of a claim element and a claim limitation, and further wherein the processing device identifies at least one of a key word and a term for at least one of defining and describing at least one of a product to which the independent claim is directed, a service to which the independent claim is directed, a claim element, and a claim limitation (see

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disclosure of the processing of claims to extract relevant terms and generate vectors, col. 13, line 12 through col. 15, line 67).

34. Regarding claims 11, 35, 61 and 85, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device formulates the search or the search query by utilizing the at least one of a key word and a term for at least one of defining and describing at least one of a product to which the independent claim is directed, a service to which the independent claim is directed, a claim element, and a claim limitation (see disclosure of the comparison of the specified patent and individual claims in the dataset, col. 26, lines 44-58; see also disclosure that the user may specify a comparison between a single claim and all other claims in the dataset, col. 27, lines 13-17 and 32-34; see also col. 4, lines 49-62).

35. Regarding claims 12, 36, 62 and 86, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device performs a search for at least one database, an information source, an information sources computer, a web site, a web page, a server computer, a chat room, and an on-line bulletin board, and further wherein the processing device obtains information regarding at least one product, products, a service, and services, which are relevant to the at least one independent claim (see disclosure that both structured and non-structured documents can be searched, said structured documents including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45).

36. Regarding claims 14, 38, 64 and 88, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device performs a search for

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information regarding at least one of a product, products, a service, and services, which are relevant to the at least one independent claim, and which contain a pre-defined number of words or terms present in the search or search query (see disclosure of the use of term frequency in determining document relevance, col. 14, line 60 through col. 16, line 56).

37. Regarding claims 15, 39, 65 and 89, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device performs a search for information regarding at least one of a product, products, a service, and services, by utilizing at least one of a search program, an intelligent agent, a search engine, a web site directory, a search engine directory and a hierarchical directory (see disclosure of the use of a document search and analysis tool, col. 6, lines 48-64).

38. Regarding claims 19, 43, 69 and 93, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device can at least one of process the information regarding the patent, generate the search of the search query, and generate the claim chart information, in any number of languages (see disclosure that the system can operate to process foreign language documents, col. 15, line 60 through col. 16, line 17).

39. Regarding claims 20, 44, 70 and 94, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device performs a search of a patent or a publication which references a patent (see disclosure that the system processes a variety of incoming documents from different sources, including U.S. Patents, col. 11, lines 21-45).

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40. Regarding claims 21, 45, 71 and 95, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device ascertains at least one of at least one of an inventor and an assignee or a patent and at least one of an author and a publisher of a publication (see disclosure that the concept query results screen includes an abbreviated section describing, *inter alia*, inventors and assignees, col. 26, lines 6-21; see also disclosure that as part of the document clustering function, documents can be displayed by presenting identifying attributes, such as title and author, col. 23, lines 42-59).

41. Regarding claims 22, 46, 72 and 96, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the processing device performs a search of information regarding at least one of a product, products, a service, and services, which is marked with at least one of a patent number and a patent pending notice (see disclosure that both structured and non-structured documents can be searched, said structured documents including patent documents, and wherein said documents can be retrieved from the Internet, col. 11, lines 15-45).

42. Regarding claims 23, 47, 73 and 97, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the claim chart information contains at least one of preamble text information for at least one of a claim element and a claim limitation, and further wherein the claim chart information contains information regarding whether an identified product or service exhibits or contains features or limitations of at least one of the claim preamble, a claim element, and a claim limitation, literally or under the Doctrine of Equivalents (see disclosure that the system will analyze all members of the database of patents against the patent entered, col. 26, lines 44-45; see also col. 27, lines 24-25; see also disclosure that the selected patent/claim is compared

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with other claims in the dataset, col. 26, lines 44-58 and col. 27, lines 13-17 and 32-34; see also disclosure that the user can display matching claims side-by-side, col. 27, lines 1-5 and 32-36; see also drawing Figure 10C, et seq.).

43. Regarding claims 24, 48, 74 and 98, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein at least one of a word, a key word, a term, and information, in the claim chart information is at least one of highlighted, underlined and emboldened (see disclosure of the highlighting of terms in the patents, col. 26, lines 22-32; see also drawing Figure 9F).

44. Regarding claims 25, 49, 75 and 99, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the method and apparatus operates automatically (see col. 3, lines 4-18; see also col. 25, lines 39-42).

45. Regarding claims 26, 50, 76 and 100, **Snyder et al.** additionally teaches a computer-implemented method and apparatus wherein the method and apparatus utilize at least one of a telecommunications network, the Internet, the World Wide Web, an RF signal communications network, a satellite communications network, an optical communications network, a public switched telephone network, a digital communications network, a personal communications services communication network, and a wireless communication network (see col. 9, lines 45-51; see also col. 10, lines 34-45; see also element 45 Internet in drawing Figure 1B).

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Claim Rejections - 35 USC § 103

46. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

47. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

48. Claims 13, 37, 63 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder et al.** (U.S. Patent 6,038,561) as applied to claims 1-12, 14, 15, 19-36, 38, 39, 43-62, 64, 65, 69-86, 88, 89 and 93-100 above, and further in view of **Reader** (U.S. Patent Application Publication 2003/0187832).

49. Regarding claims 13, 37, 63 and 87, **Snyder et al.** teaches a computer-implemented method and apparatus substantially as claimed.

Snyder et al. does not explicitly teach a computer-implemented method and apparatus wherein the search or search query contains at least one of a synonym, a dictionary definition, an equivalent term, a foreign language translation, and a slang term, for the at least one key word and a term.

Reader, however, teaches query expansion wherein the search or search query contains at least one of a synonym, a dictionary definition, an equivalent term, a foreign language translation, and a slang term, for the at least one key word and a term (see paragraph [0027]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to perform query expansion to include synonyms, since this technique ensures that documents which contain terms that are not identical, but are synonyms, can be recognized as being similar or related to similar concepts.

50. Claims 16-18, 40-42, 66-68 and 90-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder et al.** (U.S. Patent 6,038,561) as applied to claims 1-12, 14, 15, 19-36, 38, 39, 43-62, 64, 65, 69-86, 88, 89 and 93-100 above, and further in view of **Barney** (U.S. Patent 6,289,341).

51. Regarding claims 16, 40, 66 and 90, **Snyder et al.** teaches a computer-implemented method and apparatus substantially as claimed.

Snyder et al. does not explicitly teach a computer-implemented method and apparatus wherein the processing device performs a search of a web site associated with at least one of a product, products, a service, services, a trade association, a technical association, an industry association, and at least one of a manufacturer, a wholesaler, and a retailer, of at least one of a product, products, a service, and services.

Barney, however, teaches a computer-implemented method and apparatus wherein the processing device performs a search of a web site associated with at least one of a product, products, a service, services, a trade association, a technical association, an industry association, and at least one of a manufacturer, a wholesaler, and a retailer, of at least one of a product, products, a service, and services (see disclosure of the search of web sites to identify intellectual property infringement issues, col. 1, line 59 through col. 2, line 42).

It would have been obvious to one of ordinary skill in the art at the time of the invention to perform searches of web sites when seeking infringement information, since the Internet is widely used as a distribution medium for products and services, and also since web pages allow for automated searching.

52. Regarding claims 17, 41, 67 and 91, **Barney** additionally teaches a computer-implemented method and apparatus wherein the processing device performs a search of at least one of advertising information, marketing information, product review information, services review information,

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manufacturer information and distributor information (see disclosure of the search of web sites to identify intellectual property infringement issues, col. 1, line 59 through col. 2, line 42).

53. Regarding claims 18, 42, 68 and 92, **Barney** additionally teaches a computer-implemented method and apparatus wherein the processing device generates a natural language search or search query for use in obtaining information from a chat room or an on-line bulletin board (see disclosure that among the Internet sites searched are Internet Relay Chat (IRC) channels and Usenet newsgroups, in addition to other types of Internet sites, col. 2, lines 17-29).

Conclusion

54. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rivette et al. (U.S. Patent 5,623,679) teaches a system and method for creating and manipulating notes each containing multiple sub-notes, and linking the sub-notes to portions of data objects.

Rivette et al. (U.S. Patent 5,623,681) teaches a method and apparatus for synchronizing, displaying and manipulating text and image documents.

Ahn (U.S. Patent 5,696,963) teaches a system for searching an individual document and a group of documents.

Rivette et al. (U.S. Patent 5,754,840) teaches a system for developing and maintaining documents which include analyzing a patent application with regard to the specification and claims.

Rivette et al. (U.S. Patent 5,799,325) teaches a system for generating equivalent text files.

Rivette et al. (U.S. Patent 5,806,079) teaches a system for using intelligent notes to organize, link and manipulate disparate data objects.

Rivette et al. (U.S. Patent 5,809,318) teaches a method of synchronizing, displaying and manipulating text and image documents.

Rivette et al. (U.S. Patent 5,845,301) teaches a system for displaying and processing notes containing note segments linked to portions of documents.

Ahn (U.S. Patent 5,848,409) teaches a system for maintaining group hits tables and document index tables for the purpose of searching individual documents and groups of documents.

Ishimaru (U.S. Patent 5,982,931) teaches a method for the manipulation of image containing documents.

Thomas (U.S. Patent 6,401,118) teaches a method for allowing an organization or individual to monitor the Internet for violations of their intellectual property.

Carter (U.S. Patent 6,665,656) teaches a method for evaluating documents with correlating information.

Boyer et al. (U.S. Patent 6,879,990) teaches a system for identifying potential licensees of a source patent portfolio.

Imaichi et al. (U.S. Patent 7,047,255) teaches a document information display system and search method.

Reader (U.S. Patent Application Publication 2002/0147738) teaches an automated search technique for discovering patent-relevant publications on the Internet.

Poltorak (U.S. Patent Application Publication 2004/0078192) teaches a method for identifying and/or analyzing potential patent infringement.

Toong et al. (U.S. Patent Application Publication 2004/0133562) teaches a system for searching databases to identify prior art patent publications for a starting patent publication.

Poltorak (U.S. Patent Application Publication 2004/0158559) teaches a method for identifying and/or analyzing potential patent infringement.

Ogram (U.S. Patent Application Publication 2004/0243566) teaches a system for searching the Internet for web pages improperly containing material such as copyrighted cartoons, copyrighted articles, defamatory articles, and patented techniques.

Stuckman et al. (U.S. Patent Application Publication 2004/0261011) teaches a web site that displays criteria for infringement of a particular patent and accepts user input identifying an infringement target.

He et al. (U.S. Patent Application Publication 2005/0071367) teaches a method for displaying patent analysis information.

Tvito (U.S. Patent Application Publication 2006/0026146) teaches a pay-per-patent-proof system enabling a user, such as an inventor, to submit a patent search application for the purpose of assessing the patentability of an invention.

Buckman ("Data Mining for the Soft Assets") teaches the MAPIT tool, allowing one to sort through megabytes of stored patent claims and documents, looking for similarities between filings.

Calistri-Yeh et al. ("The MAPIT Patent-TSV System") provides background knowledge, theory, functional requirements, algorithm description and file/program organization of the MAPIT Patent-TSV project.

Feldman ("Manning & Napier Information Services Announces CINDOR, a Multi-Language Search-and-Retrieval System") teaches a system that can match the ideas in a query in any language to the ideas in documents in any other language.

Poltorak et al. ("Introducing Litigation Risk Analysis") teaches the use of litigation risk analysis in patent infringement litigation.

PR Newswire ("Aurigin and ClearForest Partner to Significantly Increase Search and Analysis Capabilities for Critical Patent Research") is a press release.

ClearForest ("ClearForest Announces ClearTags 4.0 for Comprehensive Content Auto-Tagging") is a press release.

ArnoldIT ("ClearForest: Cutting Through Content Clutter") teaches the features of the ClearForest product.

Robb ("Text Mining Tools Take on Unstructured Data") teaches the use of the ClearForest product.

Lau et al. ("Mining the Web for Business Intelligence: Homepage Analysis in the Internet Era") teaches the extraction of text-based personal information from web pages and its conversion into business intelligence.

Poltorak ("Industrywide Patent Enforcement Strategies, Part I") teaches how enforcement strategies in an industrywide patent enforcement campaign may differ from strategies in a single litigation.

Poltorak ("Industrywide Patent Enforcement Strategies, Part II") teaches how enforcement strategies in an industrywide patent enforcement campaign may differ from strategies in a single litigation.

Dov et al. ("Improving Knowledge Discovery by Combining Text-Mining and Link-Analysis Techniques") compares two approaches for creating links out of document features, co-occurrence and semantic.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, reading "Luke S. Wassum". The signature is fluid and cursive, with a long horizontal stroke at the end.

Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
19 June 2006